

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-13 are pending in the application, with claims 1, 5, 8, 11, 12, and 13 being the independent claims. Claims 1-10 are sought to be amended. New claims 11-13 are sought to be added. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicant respectfully requests that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Specification

The Office Action encouraged Applicant:

[to] use this period for response to thoroughly and very closely proof read and review the whole of the application for . . . general typographical errors, accuracy, assurance of proper use for Trademarks TM, and other legal symbols ®, where required[.] For example, the related United States Patent, mentioned on the first page of this application, is correctly identified as 6,622,169 not 6,662,169; correction is required.

(Office Action at ¶ 2.) Accordingly, Applicant has amended the specification to correct general typographical errors, to assure proper used of legal symbols, and specifically to correctly identify U.S. Patent No. 6,622,169.

Rejections Under 35 U.S.C. § 112

The Office Action rejected claims 1-10 under the second paragraph of 35 U.S.C. § 112 "as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention[.]" (Office Action at ¶ 4.) Applicant respectfully traverses these rejections.

Regarding claim 1, the Office Action contends that "while a server is mentioned, it has no interconnection or activity with the remainder of the system and functions among itself in limbo therefor its functions is unclear." (Office Action at ¶ 4.) Applicant respectfully traverses this rejection.

Amended independent claim 1 recites:

A system for configuring a packet switched network appliance, comprising:
a server configured to store first data, to receive second data from the packet switched network appliance via a connection-oriented switched telephony network rather than a packet switched network, and to convey third data to the packet switched network appliance via said connection-oriented switched telephony network rather than said packet switched network; and
a control routine configured to execute on said server and to use said first data and said second data to produce said third data, wherein said first data is stored by said server during said a performance of said control routine rather than received by said server from said packet switched network during said performance of said control routine and said third data configures the packet switched network appliance to have access to said packet switched network.

Thus, claim 1 particularly and distinctly recites that the server interacts with the control routine. Claims 2-4 depend upon claim 1. Accordingly, Applicant respectfully requests that the Examiner reconsider and remove his rejections of claims 1-4 under the second paragraph of 35 U.S.C. § 112.

Regarding claim 5, the Office Action contends that "it cannot be clearly ascertained how a specific network itself can configure the general appliance since a network is a set of wires absent logic." (Office Action at ¶ 4.) Applicant respectfully traverses this rejection.

Amended independent claim 5 recites:

A packet switched network appliance, comprising:

a network connection port; and

a pre-programmed configuration routine configured to interact, via said network connection port and a connection-oriented switched telephony network rather than a packet switched network, with a control routine configured to execute on a server, to convey first data to said control routine, and to receive second data from said control routine, wherein said control routine is configured to use said first data and third data to produce said second data, said third data is stored by said server during said a performance of said control routine rather than received by said server from said packet switched network during said performance of said control routine, and said second data configures the packet switched network appliance to have access to said packet switched network.

Thus, claim 5 particularly and distinctly recites how a connection-oriented switched telephony network facilitates interaction between a pre-programmed configuration routine in the packet switched network appliance and a control routine in a server to configure the packet switched network appliance to have access to a packet switched network. Claims 6 and 7 depend upon claim 5. Accordingly, Applicant respectfully requests that the Examiner reconsider and remove his rejections of claims 5-7 under the second paragraph of 35 U.S.C. § 112.

Regarding claim 1-10, the Office Action contends that, in general:

The claims recite a "specific network" and a general network". However, in light of the specification, the only real network is the local telephone network over which is laid the Internet (a logical network). Thus it cannot be clearly ascertained if the specific network and the general network are actually one and the same in construct (i.e., the "Internet" is not a different cable line from the telephone line as would be cable T.V. to the telephone since there is no "Internet" wire from a home to the street per se', the Internet is a Ghost within

the Telephone system formulated by a series of protocols among computers using the phone companies as the major means of communication with subnets (i.e., LANs local to the computers) as is FIDOnet or any other set of BBS computers using the telephone lines). That is to say, in light of the specification, the general network (i.e., Internet) is a logical sub-network overlaid the specific telephone network (i.e., POTs PSTN exc...).

(Office Action at ¶ 4.) Applicant respectfully traverses these rejections.

Rather than distinguishing between a specific network and a general network, each of amended independent claims 1, 5, and 8 distinguishes between a connection-oriented switched telephony network and a packet switched network. As noted above, the Examiner contends that "a network is a set of wires absent logic." (Office Action at ¶ 4.) Without stipulating to this definition of a network, each of amended independent claims 1, 5, and 8 characterizes the networks by the manner in which they convey information. Thus, each network is particularly and distinctly distinguished from the other. Claims 2-4, 6, 7, 9, and 10 depend upon claims 1, 5, or 8. Accordingly, Applicant respectfully requests that the Examiner reconsider and remove his rejections of claims 1-10 under the second paragraph of 35 U.S.C. § 112.

Double Patenting

The Office Action rejected claims 1-10 "under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of United States Patent 6,622,169 and/or 6,161,133." (Office Action at ¶ 7.)

Applicant has filed herewith a Terminal Disclaimer to Obviate a Double Patenting Rejection Over a Prior Art with respect to U.S. Patent No. 6,161,133, thereby rendering these

rejections moot with respect to U.S. Patent No. 6,161,133. Applicant has also filed herewith a Terminal Disclaimer to Obviate a Double Patenting Rejection Over a Prior Art with respect to U.S. Patent No. 6,622,169, thereby rendering these rejections moot with respect to U.S. Patent No. 6,622,169. Accordingly, Applicant respectfully requests that the Examiner reconsider and remove his rejections of claims 1-10 under the judicially created doctrine of obviousness-type double patenting with respect to U.S. Patent Nos. 6,161,133 and 6,622,169.

Rejections Under 35 U.S.C. § 102

The Office Action rejected claims 1-10 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,370,141 to Giordano, III *et al.* (hereinafter "Giordano"). (See, Office Action at ¶ 9.) Applicant respectfully traverses these rejections.

Regarding amended independent claim 1, it recites (emphasis added):

A system for configuring a packet switched network appliance, comprising:

a server configured to store first data, to receive second data from the packet switched network appliance via a connection-oriented switched telephony network rather than a packet switched network, and to convey third data to the packet switched network appliance via said connection-oriented switched telephony network rather than said packet switched network; and

a control routine configured to execute on said server and to use said first data and said second data to produce said third data, wherein ***said first data is stored by said server during a performance of said control routine rather than received by said server from said packet switched network during said performance of said control routine*** and said third data configures the packet switched network appliance to have access to said packet switched network.

Giordano does not disclose, teach, or suggest a control routine configured to execute on a server to use data, stored by the server during a performance of the control routine rather than received by the server from a packet switched network during the performance of the

control routine, to configure a packet switched network appliance to have access to the packet switched network. Consequently, claim 1 is not anticipated by Giordano. Claims 2-4 depend upon claim 1. Accordingly, claims 2-4 are also not anticipated by Giordano.

Regarding amended independent claim 5, it recites (emphasis added):

A packet switched network appliance, comprising:
a network connection port; and
a pre-programmed configuration routine configured to interact, via said network connection port and a connection-oriented switched telephony network rather than a packet switched network, with a control routine configured to execute on a server, to convey first data to said control routine, and to receive second data from said control routine, wherein said control routine is configured to use said first data and third data to produce said second data, ***said third data is stored by said server during a performance of said control routine rather than received by said server from said packet switched network during said performance of said control routine***, and said second data configures the packet switched network appliance to have access to said packet switched network.

Giordano does not disclose, teach, or suggest a control routine configured to execute on a server to use data, stored by the server during a performance of the control routine rather than received by the server from a packet switched network during the performance of the control routine, to configure a packet switched network appliance to have access to the packet switched network. Consequently, claim 5 is not anticipated by Giordano. Claims 6 and 7 depend upon claim 5. Accordingly, claims 6 and 7 are also not anticipated by Giordano.

Regarding amended independent claim 8, it recites (emphasis added):

A method for configuring a packet switched network appliance, comprising:
(a) pre-programming the packet switched network appliance with a first configuration routine configured to interact with a configuration server having a second configuration routine;
(b) connecting the packet switched network appliance to said configuration server via a connection-oriented switched telephony network rather than a packet switched network;

(c) providing an initiation signal causing the packet switched network appliance to establish communication and initiate interaction with said configuration server; and

(d) configuring the packet switched network appliance for access to said packet switched network by interaction of said first configuration routine and said second configuration routine;

wherein said first configuration routine is configured to convey first data to said second configuration routine and to receive second data from said second configuration routine, said second configuration routine is configured to use said first data and third data to produce said second data, *said third data is stored by said server during a performance of said second configuration routine rather than received by said server from said packet switched network during said performance of said second configuration routine*, and said second data configures the packet switched network appliance for access to said packet switched network.

Giordano does not disclose, teach, or suggest a control routine configured to execute on a server to use data, stored by the server during a performance of a configuration routine rather than received by the server from a packet switched network during the performance of the configuration routine, to configure a packet switched network appliance for access to the packet switched network. Consequently, claim 8 is not anticipated by Giordano. Claims 9 and 10 depend upon claim 8. Accordingly, claims 9 and 10 are also not anticipated by Giordano.

Therefore, Applicant respectfully requests that the Examiner reconsider claims 1-10 and remove the rejections of claims 1-10 under 35 U.S.C. § 102(e).

Conclusion

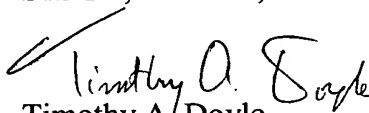
All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding objections and rejections and that they be

withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

A handwritten signature in black ink, appearing to read "Timothy A. Doyle". The signature is written in a cursive, flowing style.

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